

REMARKS/ARGUMENTS

Favorable reconsideration of this application in view of the above amendments and following discussion is respectfully requested.

Claims 8-14 are pending in this application. By this amendment, Claims 8, 13 and 14 are amended; and no claims are canceled or added herewith. It is respectfully submitted that no new matter is added by this amendment.

In the outstanding Office Action, Claims 8, 9, 13 and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,301,607 to Barracclough in view of U.S. Patent No. 6,535,228 to Bandaru; and Claims 10-12 were rejected under 35 U.S.C. § 103(a) as unpatentable over Barracclough in view of Bandaru and further in view of U.S. Patent No. 5,838,314 to Neel.

The applied art does not teach or suggest a user contents control unit configured to control recording of the data received by the receiving unit into a recording area corresponding to each user apparatus with a user ID indicating each user who offers the data to be shared and a shared data flag set by the user in a database, and a shared contents control unit configured to control the recorded contents based upon the shared data flag, as claimed in Claim 8 and similarly claimed in Claims 13 and 14.

Barracclough et al. discloses capturing images with a digital camera or camcorder 100 and downloading them to an Internet appliance 110. The images are attached to an electronic communication and sent to a web server 120 via the Internet. At the web server 120, the images are parsed and posted to a web page. A second electronic communication is sent from the web server 120 to individuals selected by the sender of the images, notifying the individuals of the new posting on the web page. The second electronic communication is sent automatically. In this way, the sender of the first electronic communication can communicate with the selected individuals.

Accordingly, Barracrough does not teach or suggest having data transmitted from a plurality of user apparatus and a user contents control unit configured to control recording of the data received by the receiving unit into a recording area corresponding to each user apparatus with a user ID indicating each user who offers the data to be shared and a shared data flag set by the user in a database. Instead, Barracrough merely teaches having images that are parsed and posted to a web page.

Bandaru does not make up for the deficiencies of Barracrough discussed above. Bandaru discloses as shown in Figure 16, the ability of a user to select one or more share lists from the available share list. That is, at block 1605, the user indicates on the DMF that a share operation is to be performed. At block 1610, the DMF displays the available objects in the DMF to allow the member to select one or more objects to be shared. The selected objects can be distinguished from the non-selected objects by a check mark or bold border. When the member completes the selection, the DMF displays the available share list previously generated by a member. At block 1615, the member may select multiple share lists in which case the recipients in the multiple share lists receive the selected objects. At block 1620, the DMF network sends a copy of the selected objects to each of the recipients identified in the selected share list.

Further, it is respectfully submitted that there is no basis in the teachings of the applied art to support their applied combination. Certainly, the outstanding Office Action fails to cite to any specific teachings within the references to support the applied combination. Accordingly, it is respectfully submitted that the combination of Barracrough in view of Bandaru is the result of hindsight reconstruction in view of the teachings of the present specification, and is improper.

When an obviousness determination is based on multiple prior art references, there must be a showing by the patent examiner of some “teaching, suggestion, or reason” to

combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”). Whether motivation to combine the references is shown is a question of fact. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, *inter alia*, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. “Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter.” Winner International Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000). Interpreting the Supreme Court's decision in Dickinson v. Zurko, 50 USPQ2d 1930 (1999) regarding the standard of review in patent matters, the CAFC determined that when upholding a rejection of a claimed invention in an appeal, the CAFC must find that the decision by the USPTO Board of Appeals and Interferences is supported by “substantial evidence,” In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000). Accordingly, for a proper rejection based on a combination of references, the rejection must be supported by evidence that the motivation to combine references was not merely feasible, but desirable.

Barracough is merely concerned with allowing a user to post pictures and notify others that a website has been created showing the pictures. There is no motivation to modify the teachings of Barracough to allow for a user contents control unit to control a recording

area corresponding to each user apparatus with a user ID indicating each user who offers the data to be shared. The teachings of Barracough are for only a single person to share their pictures with selected others. Accordingly, withdrawal of the rejection of the claims under 35 U.S.C. § 103 is respectfully requested.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 8-14 is patentably distinguishing over the applied art.

The present application is therefore believed to be in condition for formal allowance and favorable reconsideration of this application as presently amended is respectfully requested.

Respectfully submitted,

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